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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,846	02/06/2002	Bryan G. Hughes	400064.401	3733

500 7590 12/15/2004

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EXAMINER	
NGUYEN, KIM T	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/072,846	HUGHES, BRYAN G.	
	Examiner	Art Unit	
	Kim Nguyen	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *135-156* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *135-156* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The reply filed on 9/21/04 is acknowledged. Curently, claims 1-134 have been canceled, claims 135-156 have been added, and claims 135-156 are now pending in the application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 136 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 136, line 5, the claimed limitation "linking to a corresponding location on a network" is ambiguous. It is not clear what should be linked to a location on a network. Further, how can a concept (abstract object) be linked to a physical location of a network?

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 135-156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (US 2002/0002489) in view of Leason et al (US 6,251,017).

a. As per claim 135 and 141, Miller discloses a method comprising receiving a number of indications identifying a first type of action (user selects combination of numbers with commercial icons such as vehicles, boat, etc.) (Figs 7A-7C; paragraphs 0072-0073); determining whether the received indications of the first type of action matched a winning combination; and providing an award if there is a matched (abstract, paragraphs 0068, 0074). Miller does not disclose providing commercial icons for selection. However, Leason discloses providing commercial icons for the user to select (col. 9, lines 26-32). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include commercial icons of Leason to the game of Miller in order to enhance attraction on commercial advertisement items on the game of Miller.

b. As per claim 136-138, Miller discloses linking a location to a website on a network (Fig. 7D; paragraphs 0081 and 0068). Further, regarding to claims 137-138, Miller discloses allowing the user to play a second round by selecting different type of actions (paragraphs 0082-0083) , and presenting an advertisement (paragraphs 0075 and 0083) provided by a commercial entity.

c. As per claim 139-140, and 142-146, implementing button associating an icon for selecting the icon, providing promotional offer, changing the appearance of a selected icon to a specific image such as a trademark, etc., presenting the image on a display or an audio track, and accepting all the users' selections before determining winning would have been well known to a person of ordinary skill in the art at the time the invention was made.

d. As per claim 147, refer to discussion in claims 135 and 137 above.

e. As per claim 148, Leason discloses presenting icons via a graphical user interface (col. 9, lines 18-21).

f. As per claim 149-150, Miller discloses presenting an advertisement by linking the user to a website that is associated with the commercial icon (Fig. 7D).

g. As per claim 151, 153-154, linking the user to a page of the website that is different from the commercial entity, receiving a set of indication before another set of indication of another type of action, and accepting input of selection of all the users before awarding an award would have been both well-known and obvious design choice.

h. As per claim 152, refer to discussion in claim 140 above.

i. As per claim 155 and 156, refer to discussion in claims 135, 137, and 139 above.

Response to Arguments

5. Applicant's arguments with respect to claims 1-134 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9306, (for formal communications; please mark "EXPEDITED PROCEDURE")

Hand-delivered responses should be brought to Crystal Plaza II, Arlington, VA Second Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (571) 272-4441. The examiner can normally be reached on Monday-Thursday from 8:3OAM to 5:OOPM ET. The central official fax number is (703) 872-9306.

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Date: December 7, 2004

KIM NGUYEN
PRIMARY EXAMINER